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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/859,935 03/30/92 EDGERTON

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EXAMINER

ELEY, T

ART UNIT

PAPER NUMBER

3206

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DATE MAILED:

01/12/93

HENDERSON AND STURM
1213 MIDLAND FINANCIAL BLDG.
DES MOINES, IA 50309

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input checked="" type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-19 are pending in the application.
Of the above, claims 4-19 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-3 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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(1) Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-3, drawn to a method of placing braille letters on an architectural sign face, classified in Class 29, subclass 525.

II. Claims 4-19, drawn to an apparatus for placing braille letters on an architectural sign, classified in Class 29, subclass 700.

(2) The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such simply drilling holes in a metal frame.

(3) Because these inventions are distinct for the reasons given above and have acquired a separate status in the art restriction for examination purposes as indicated is proper.

(4) During a telephone conversation with Mr. Michael Sturm on December 18, 1992 a provisional election was made with the right

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to traverse to prosecute the invention of Group I, claims 1-3. Affirmation of this election must be made by applicant in responding to this Office action. Claims 4-19 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

(5) The disclosure is objected to because of the following informalities: In claim 1, line 10; "extend" should be --extends--. In claim 3, line 6; --of-- should be inserted after "one". In claim 3, line 8; "the" should be deleted. Appropriate correction is required.

(6) The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

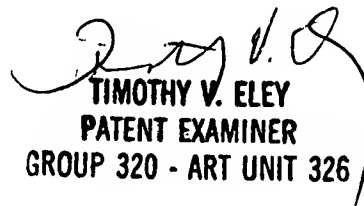
(7) Claims 1-3 are rejected under 35 U.S.C. § 103 as being unpatentable over either Zagler et al or the French reference, each considered independently. Both Zagler et al and the French

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reference disclose a method of placing braille letters on an architectural sign face by fastening separate members into each of a plurality of holes in a sign. Neither reference discloses drilling of the holes nor forcing a sphere into each of the holes to an extent greater than the radius thereof. However, drilling would have been an obvious method of making the holes to one skilled in the art, and exactly how far the spheres are forced into the holes is seen to be an obvious matter of choice and structural design depending upon the design height of the braille lettering.

(8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(9) Any inquiry concerning this communication should be directed to Timothy Eley at telephone number (703) 308-1824.


TIMOTHY V. ELEY
PATENT EXAMINER
GROUP 320 - ART UNIT 326

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January 5, 1993